

REMARKS

The Office Action of May 6, 2003 has been reviewed and carefully considered.

In this response to the Office Action, claim 4 has been amended, and new claims 8 and 9 have been added to the application. Claims 4 through 9, of which only claim 4 is independent, are now pending.

Reconsideration of the above-identified application, as herein amended, is respectfully requested.

At the outset, appreciation is expressed for the courtesies extended by Examiner Castellano in the telephone interview with the undersigned on September 22, 2003. In the course of that interview, the rejections set forth in the May 6, 2003 Office Action, the cited Bagwell et al patent (U.S. Patent No. 5,101,997), and then-pending claims 4 to 7 (i.e. the claims pending prior to the amendments effected herein) were discussed.

In the Office Action of May 6, 2003, independent claim 4 stands rejected as allegedly anticipated by Bagwell.

Bagwell discloses a multiple receptacle container for receiving articles of waste. The container 10 of Bagwell includes an underlying base 16 that supports a unitary frame 14 to which a plurality of receptacles or bins 12 are detachably secured. The frame 14 is formed by a vertical support member or shaft 18 and a pair of vertical support strips 19, all three of which are secured to and extend upwardly from the base 16. A pair of horizontal cross-members 20 are integrally secured to and respectively connect the vertical support strips 19 to the vertical support member 18, to thereby form a unitary, rigid structure comprised of the base 16, the two vertical support strips 19, the vertical support member 18 and the two horizontal cross-members 20. The vertical support member 18, which Bagwell shows and describes as an elongated tube, is further

provided with a "cup 21 secured to its upper end", and the plural waste-receiving bins are releasably attached in hanging relation from the unitary support structure by engagement of a hook 34 defined on each bin 12 with the cup 21 into which the hooks 34 are received for attachment of the bins to the support structure.

The underlying support base 16 of Bagwell itself sits on a stand 28 that carries a bearing race 26 interposed between the base 16 and stand 28 so that the base 16 -- and, with it, the rigid support structure to which the multiple waste article bins 12 are releasably attached -- is rotatable relative to the supporting stand 28 about a central axis defined by the vertical support member 18 which projects upwardly from the base 16. The stand 28 is, in turn, supported on an underlying floor surface by casters 32 which are pivotally mounted to and extend downwardly from the stand 28 to "allow lateral movement of the entire receptacle 10 in virtually any direction. Thus, the combination of the bearing assembly 22 and the casters 32 allows positioning of the receptacle 10 in any accessible location and orientation of the bins 12 as desired." (See Bagwell at col. 2, l. 65 through col. 3, l. 4).

Finally, the topmost end of each of the two vertical support strips 19 includes "a handle 38 ... to facilitate handling the receptacle 10." (Bagwell col. 3, ll. 14-16).

Thus, as is evident, the waste articles container of Bagwell et al. is especially constructed, configured and, as Bagwell clearly discloses and teaches, is intended for being supported directly on an underlying ground or floor surface by the caster-carrying tray 28 on which the unit's base 24 sits, and relative to which the tray (and attached support structure and bins) is rotatable about the central axis defined by the bearing race 26.

The present invention, on the other hand, is directed to, and the application specification indisputably discloses and teaches, a waste bin assembly that includes a plurality of

waste-receiving compartments and which is expressly constructed and configured for mounted securement to the underside of an elevated work surface so as to suspend the plural waste-receiving compartments from the elevated work surface. An elongated shaft extends from the mounting unit at one (i.e. the top) end of the shaft to the plural waste receiving compartments at the opposite (i.e. lower) end of the shaft. The plural waste-receiving compartments are detachably secured to the shaft such that they are suspended from the shaft without direct support from the underlying floor surface. A bearing in the mounting unit enables selective axial rotation of the shaft and the suspended waste-receiving compartments, relative to the elevated work surface to which the assembly is mounted, for enhanced user access to selected individual ones of the plural waste-receiving compartments.

The waste bin assembly of the present invention is not intended for direct support on an underlying floor surface and, indeed, to place it atop an underlying floor surface would not only defeat its expressly disclosed and intended utility but would not likely permit the assembly to be used for its intended purpose. If the inventive assembly were to be placed upright directly on the floor, the waste-receiving compartments would almost certainly unintentionally become detached from the support shaft and fall over on their sides. Moreover, even if the components of the assembly, sitting on the floor, remained connected to each other, there would be no way to rotate the assembly (other than to slide the entire assembly along the floor surface) since the mounting unit, which contains the bearing assembly that enables rotation of the shaft and suspended waste-receiving compartments, is located remote from the bottom of the unit (which would be resting on the floor) so that the mounting unit can be attached to the underside of an elevated work surface in order to suspend the waste-receiving compartments from the underside of the elevated work surface.

Similarly, the Examiner's suggestion in the Office Action that the waste bin assembly of Bagwell is "capable of being secured to the underside of the elevated work surface for suspending the compartments from the work surface" is neither supported by the Bagwell disclosure nor suggested by its teachings, and neither would such an imagined securement permit the Bagwell assembly to function in the manner of the present, claimed invention without completely rebuilding and reconstructing the Bagwell assembly in a futile effort to artificially meet the claimed structure of the present invention. Where is there any teaching or suggestion for mounting the Bagwell assembly -- which is specially constructed for direct support on an underlying floor surface -- to the underside of an elevated work surface? And how is such a mounting to be accomplished, without adding additional structural elements to the article that Bagwell discloses? The cutouts at the top of the vertical support strips 19 are taught by Bagwell to be "handles" and, even if *arguendo* those openings were to be used to mount the Bagwell assembly to the underside of an elevated work surface, the open ends of the waste-receiving bins 12 of the assembly shown and described in the Bagwell patent would be so close to the underside of the elevated work surface that it would be impossible to insert any waste or other matter into the bins -- to say nothing of the fact that Bagwell lacks any disclosure or teaching or suggestion for such a mounting of the assembly which flies directly in the face of the direct support of the assembly by an underlying floor surface that Bagwell expressly teaches. What the Examiner is doing is pure and simple hindsight reconstruction, impermissible rebuilding of applicant's invention, based on knowledge of applicant's disclosure, using a prior art reference that lacks sufficient disclosure to either read on or even suggest a modification for the purpose of meeting the recitations of applicant's claims.

Applicant sincerely believes that independent claim 4, in the form that was the subject of the Examiner's rejections in the Office Action of May 6, 2003, easily distinguishes over

the Bagwell reference and, indeed, of any prior art of which applicant is aware. Nevertheless, in an effort to still more clearly define an essential and fundamental aspect of applicant's invention -- namely, that applicant's waste bin assembly is configured and constructed for securement directly to the underside of an elevated work surface -- applicant has herein further amended independent claim 4 to now state that the mounting unit is "constructed and positioned for securement of the mounting unit directly to the underside of the elevated work surface for suspending the plural waste-receiving compartments from the elevated work surface". This, and other language located throughout the remainder of independent claim 4, makes it crystal clear that applicant's claimed invention is limited to a mounting unit structure that is "constructed and positioned" for suspending the plural waste-receiving compartments from the elevated work surface by securing the mounting unit directly to the underside of the elevated work surface.

In the course of the September 22, 2003 telephone interview discussed above, the Examiner contended that the "functional language" in applicant's claims related to the intended securement of the mounting unit to the elevated work surface for suspending the plural waste-receiving compartments from the elevated work surface is not a structural limitation and therefore has no weight or bearing in evaluating the patentability of the claim over the cited prior art. Applicant, as expressed during the telephone interview, strongly disagrees because the subject language helps to define and limit the claimed structural elements of the inventive assembly. Applicant points out that claim 4 now recites that the mounting unit is "constructed and positioned for securement of the mounting unit directly to the underside of the elevated work surface for suspending the plural waste-receiving compartments from the elevated work surface". Accordingly, claim 4 recites that the mounting unit is "constructed and positioned" *so that* it can be secured to the elevated work surface *so as to* suspend the waste-receiving compartments from the elevated work

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surface. This language, which the Examiner contended to be "merely functional", in fact serves to precisely define structural attributes of interrelated component parts of the claimed assembly. As noted in the Manual of Patent Examining Procedure:

" In a claim that was directed to a kit of component parts capable of being assembled, the court held that limitations such as 'members adapted to be positioned' and 'portions...being resiliently dilatable whereby said housing may be slidably positioned' served to precisely define present structural attributes of interrelated component parts of the claimed assembly." *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976)." (MPEP § 2173.05(g))

The functional limitations recited in applicant's claims are properly used in association with claimed structural elements of the assembly to define a particular capability or purpose that is served by the recited elements, and should be evaluated and considered, just like any other limitation of a claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. The Examiner is incorrect in simply disregarding those limitations in applicant's claims in considering the patentability of the claims over the cited art.

Neither the Bagwell reference, nor any of the art cited by the Examiner, whether considered alone or in combination, discloses or suggests "a mounting unit constructed and positioned for securement of the mounting unit directly to the underside of the elevated work surface for suspending plural waste-receiving compartments from the elevated work surface", as is recited in applicant's claim 4. For *at least* this reason, applicant submits that independent claim 4, and each of the remaining claims dependent therefrom, patentably distinguish over the prior art and should be allowed.

New dependent claim 8 states that each of the waste receiving compartments of applicant's waste bin assembly includes an opening to which articles of waste are selectively depositable into the compartments, and further recites that the mounting unit is disposed (in the

orientation of the waste bin assembly for use secured to the underside of an elevated work surface) in spaced relation above the openings of the plural waste receiving compartment. This construction is clearly neither disclosed nor suggested by Bagwell or any of the other prior art of record.

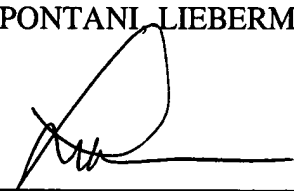
New dependent claim 9 recites that each of the waste receiving compartments includes an opening through which articles of waste are selectively depositable into the waste receiving compartments, and further recites that the "one end" of the elongated shaft extends above and beyond the openings of the plural waste receiving compartments when the waste bin assembly is oriented for normal use secured to the underside of an elevated work surface. Here, too, no such structure is either shown or suggested by Bagwell or any of the other art of record.

For at least the foregoing reasons, it is believed and respectfully submitted that claims 4 through 9 are in condition for allowance and such action, and early passage of the case to issue, are once more requested.

Respectfully submitted,

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